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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/156,952
Filing Date: September 18, 1998
Appellant(s): OSTGAARD ET AL.

Michael J. Bolan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/12/2005 appealing from the Office action
mailed 1/11/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claims 1-8, 10, 12-26 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Brodner (UPS 5,894,733) in view of Moore (USP 5,855,289). The Examiner has already applied these reference in one 103 rejection (See 103 Rejection and Response to Arguments below). This rejection involved the Examiner's belief that the combination of Brodner and Moore yielded a "generally flat, lower most surface that extends radially outward from the outer body surface of the vial along a plane

perpendicular to the body outer surface". The Examiner has argued that this feature is present in the Brodner reference based on geometry (See Response to Arguments). The Examiner now also argues that even if it were not present, then it would be obvious to one of ordinary skill in the art to vary the shape of the lug feature within limits that still provide the function of the lug element. As noted in the previous Board Decision (page 7), the specification lacked textual support for the previous claim requirement defining the shape of a lower most edge as "substantially perpendicular". The specification stated that "other suitable materials, dimensions, and configurations for the body, the cap, the ribs, the lugs, the fluid level indicia and other features of the sample vial will be apparent to those skilled in the art, those disclosed being provided as examples only" (Specification, page 14, lines 14-16). Appellant has now amended the claim to recite a lower most surface that is "generally flat" and "extending radially outwardly from said body outer surface along a plane perpendicular to the body outer surface". Given Appellant's own disclosure and Appellant's lack of any evidence as to how this specific configuration or shape distinguishes Appellant's lug over the element from Brodner and Appellant, the Examiner believes that varying the shape of the lug feature – while still maintaining the function of the lug – would be obvious to one of ordinary skill in the art. Therefore, the claims are rejected.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,894,733	BRODNER	4-1999
5,855,289	MOORE	1-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8, 10 and 12-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodner (5,894,733) in view of Moore (5,855,289). Brodner teaches the use of polypropylene (column 3, lines 1 1-13) combination 14 sample vial comprising a sleeve

12 and inner container 10. The combination having an outer surface 55, an open end and closed bottom end (Fig. 2). The vial combination comprising a plurality of integral anti-rotation lugs 56 about the outer surface of the cylindrical body (Figs. 2-3). Wherein the anti-rotation lug comprises a flat, longitudinally disposed surface extending radially outwardly from the body outer surface, which is substantially perpendicular to the body of the vial. Moreover, the surface of the plurality of anti-rotation lugs is accessible when the cap 24 of combination container 14 is engaged with the neck of vial 12 (Fig. 4). Additionally, the lugs have a lowermost edge that is located closer to the open end than to the closed end (Fig. 2). Moreover, Brodner discloses a seal means 32 and 52 disposed between the body and the cap, which seals fluid within the container to assist in long term preservation of contents (Figs. 2-3). Brodner does teach the vial comprising identification markings 72 (column 1, lines 27-42, column 4, lines 4-10). However, Brodner does not specifically recite a first alignment marker on the body or the cap and a second alignment marker on the body, or the cap comprising a torque pattern with a plurality of radially disposed ribs. Moore teaches a sample vial for use in an automated test apparatus comprising a body with an outer surface, an open end, a closed end, and a cap 34 releasably engagable with the body. The cap comprising an outer surface and a torque pattern (Fig. 1 & 3) on the outer surface, wherein the torque pattern comprising a plurality of radially disposed ribs 64. The vial includes seals 54, 98 disposed between the body and the cap so as to be capable of forming a substantially fluid-tight seal therebetween. Moore teaches the cap comprising first screw threads 62 (Fig. 4) and a second mating screw thread 80 on the body (Fig. 1). Additionally, Moore

teaches sample fluid level indicia 108 comprising an upper fill line and a lower 511 line on the outer surface of the vial body (Fig. 1). Moore teaches a first alignment marker 110 on the body on the cap and a second alignment marker 108 on the body (column 7, lines 24-4%). Moreover, Moore teaches a proximate structure comprising a storage container and vial sleeve 26 (Figs. 1-2). Moore teaches the creation of a fluid-tight seal formed between the body and the cap. However, neither Brodner nor Moore disclose the specific range of torque between 5 and 50 inch-pound of torque applied to the cap. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included in the invention of Brodner and Moore the range of torque between 5 and 50 inch-pound of torque applied to the cap in order to ensure the cap and vial are properly sealed and prevent the leakage of a sample or air from the vial. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the invention of Brodner a first alignment marker on the cap and a second alignment marker on the body, as taught by Moore, in order to insure a fluid- tight seal after a predetermined amount of rotational movement has been achieved between the cap and the vial. This would prevent the possibility of damaging the seal by over tightening the cap (column 7, lines 24-34).

(10) Response to Argument

Appellant has stated that the issue before the Board is whether the lugs of Brodner include a specific feature that appellant believes is NOT provided. This feature of the lug is "a generally flat, lower-most surface that extends radially outward from the outer body surface of the vial along a plane perpendicular to the body outer surface". Appellant believes this feature is not present in the prior art Brodner. The Examiner respectfully disagrees. The Examiner believes that Appellant is arguing beyond the scope of this limitation as it is currently written.

The Examiner reminds Appellant that the contended limitation of claim 1 is drawn to a lug having a lower most surface that extends radially outward **from the body outer surface along a PLANE perpendicular to said body outer surface**. A plane is a different geometric entity than a line. The Examiner believes this distinction is critical as it means a claim that limits a feature to being "along a plane" is broader than claim language that limits a feature to being "along a line". Based on the submitted Figures, it appears to the Examiner that Appellant is arguing that the **line** formed by the lowermost surface of the lug of their device must be perpendicular to the body surface.

On page 6 of submitted arguments, Appellant has provided a close-up view of Figure 5 from their disclosure. As noted by Appellant on page 5, lines 10-13, this Figure provides a front, cutaway view of the vial (12) and lug element (18). Appellant has also added an additional feature – labeled "P1". Appellant then states that P1 is the plane along which the lower-most surface of the lug extends. The Examiner respectfully disagrees. The added feature "P1" is not a plane, but a line. Therefore, P1 is a representation of the **line along which the lower-most surface of the lug extends –**

not the plane. The Examiner concedes that this line – P1 - appears to be perpendicular to the body outer surface in the dimension shown by Appellant. Appellant then provides a close up view of Figure 2 from Brodner on page 8 of Arguments. This Figure is a front, cutaway view of the sleeve (12) and ridge element (18). Appellant has also added elements "P2" and "P3" and referred to them as "planes". The Examiner again disagrees. These are lines – not planes. Appellant then states that the line - P2 - formed by the tapering lowermost surface of the lug of Brodner does not form a perpendicular angle with the body outer surface. The Examiner also agrees with Applicant's assertion that this line does not form a perpendicular angle with the body outer surface.

So, it appears to the Examiner that Appellant has shown that the line – P1 – formed by the lower-most lug of the instant device is perpendicular to the body outer surface, while the line formed by the lower-most surface of the lug of Brodner - P2 - is not perpendicular to the body outer surface. Appellant then argues that this difference in angles is what distinguishes the instant device over the prior art. The Examiner respectfully disagrees and again cites the fact that the claim does **not** require that the lower-most surface of the lug extend radially outward from the body surface along a *line* that is perpendicular to the body surface, but instead states the that the lower-most surface of the lug extend radially outward from the body surface along a *plane* that is perpendicular to the body surface. As noted above, the Examiner believes that Appellant's use of the term plane broadens the scope of the claim beyond Appellant's current arguments. Limiting the extension of the lug surface along a plane is

considerably broader than if the extension were limited to a line. Therefore, the pertinent issue for this argument is not what angle the *line* made by the lowermost surface of the lug forms with the body outer surface. Instead, the issue is the angle is formed between the ***plane that this line resides in*** and the body outer surface since this what the claim recites. Given this assertion, the Examiner believes Brodner still meets the limitation of the claim as written.

The Examiner will now explain what he considers to be the “plane” that both contains the line extension of the lower-most surface and is perpendicular to the body outer surface. The Examiner directs Appellant to Figure A (included with the Answer). This Figure is the same Figure submitted by Appellant on page 8 of Arguments. The Examiner has now added several dotted lines to this Figure which outline a plane – labeled PL1. (The Examiner wishes to note that while a plane extends infinitely in two dimensions, the Examiner has only illustrated a small portion of the plane in this Figure.) The plane PL1 contains the line P3. It also contains the line P2. If the Examiner were to use Appellant’s Figure as a guide, this plane would basically be in the plane of the sheet of paper. Therefore, the Examiner believes that the lower-most surface of Brodner’s lug/ridge extends along a line that is contained in the plane PL1. The Examiner now refers to Figure B. This is Figure 3 of Brodner (a top view of the sleeve structure) with additional, thicker lines with arrows added. These additional, thicker lines represent a top view of the plane, PL1 from Figure A. As can be seen from Figure B, plane PL1 – while extending through the page in this view – also extends in a direction (shown by the arrows) that is away from the body surface (towards the right

edge of the page). This direction is clearly perpendicular to the outer surface of the body in this view. Again, line P3 lies in this plane. It is for this reason that the Examiner believes Brodner meets Appellant's limitation. While the line P3 is not perpendicular to the outer surface of the body – which is what was argued by Appellant - the plane PL1 that contains the line extension IS perpendicular to the body. This is what the claim requires. The claim states that the lower-most surface of the lug extends radially outward along a plane perpendicular to the surface.

Even if the Examiner **were** to read the limitation of the claim in the manner in which Appellant has argued (i.e. that the lower-most surface of the lug must extend along a line that is perpendicular to the body outer surface) then the Examiner still fails to see how this distinguishes the anti-rotation lug of the instant device over the ridge of Brodner. Appellant would again be arguing that the non-tapering surface of the lug of instant device is distinguishable over the tapering surface of the ridge of the prior art based solely on the difference between the lower-most surface(s) of the contested feature. This is not persuasive. The anti-rotational ridge element of Brodner serves the same function as applicant's lug even with the taper. In addition, the Specification states that "other suitable materials, dimensions, and configurations for the body, the cap, the ribs, the lugs, the fluid level indicia and other features of the sample vial will be apparent to those skill skilled in the art, those disclosed being provided as examples only". This was also noted in the previous Appeal Decision (dated October 23, 2003) in the section (page 7, line 6 – page 8, line 4) discussing Appellant's lack of textual support for the lug feature. The Board stated that it was significant that there is no

textual support for a lower-most edge of the anti-rotational lug being substantially perpendicular to the body outer surface. Therefore, the Examiner fails to see how the non-tapered surface of the instant device is distinguishable over the tapered surface of the prior art given Appellant's own admission that the lug may vary in dimension and configuration from that which is shown in the Figures. In addition, Appellant has not submitted any evidence which may show a distinction between the two different lug surfaces.

For the above reasons, it is believed that the rejections should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Dwayne K Handy/
Examiner, Art Unit 1797

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Gregory L Mills/
Acting Director of Technology Center 1700

Conferees:

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

/Patrick J. Ryan/
Supervisory Patent Examiner, Art Unit 1795